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10/608,053	06/27/2003	Michael J. Robinson	1925-1-3	7898
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EXAMINER				
SMITH, MARCUS				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,053

Applicant(s)

ROBINSON, MICHAEL J.

Examiner

MARCUS R. SMITH

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-13, 15-18, and 34-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Cannon (US 6,842,447).

with regard to claims 1 and 34, Cannon teaches:

A gateway for using non-IP digital PBX telephone handsets with an IP call controller, comprising:

(a) one or more handset ports (telephone) for coupling to one or more non-IP digital PBX telephone handsets (column 3, lines 15-25);

(b) an IP port for coupling to an IP network device (column 3, lines 20-25); and

(c) a protocol translator (signal gateway, 47) circuit (column 4, lines 36-50) that

(i) translates non-IP digital PBX telephone call control signals (ISUP messages) received at a handset port into IP telephone call control signals (SIP signals) for an IP telephone call controller and delivers them to the IP port (column 5, lines 1-15); and

(ii) translates IP telephone call control signals received at the IP port from an IP telephone call controller into non-IP digital PBX telephone call control signals and delivers them to the one or more handset ports (column 5, lines 1-15).

with regard to claim 15, Cannon teaches:

A system wherein non-IP digital PBX telephone handsets are coupled to an IP telephone call controller in a public telephone network, comprising:

(a) an IP telephone call controller (proxy server, 42, SIP server) operating a public telephone network according to public IP call control protocols and coupled to the global IP network (column 3, lines 30-35);

(b) a gateway coupled to the global IP network at a location remote from the IP telephone call controller (column 3, lines 20-25);

(c) one or more non-IP digital PBX telephone handsets coupled to the gateway via wires for carrying non-IP digital PBX telephone call control signaling between the handset and the gateway (column 3, lines 15-25);

(d) the gateway having one or more protocol translating circuits that (column 4, lines 36-50):

(i) translate non-IP digital PBX call control signals received from a handset into IP call control signals according to the public IP call control protocols of the call controller (column 5, lines 1-15) and

(ii) translate IP call control signals from the call controller into non-IP digital PBX call control signals for a handset coupled to the gateway (column 5, lines 1-15).

with regard to claims 17, Cannon teaches:

A system wherein non-IP digital PBX telephone handsets are coupled to a proprietary IP telephone call controller in a private telephone network, comprising:

(a) a proprietary IP telephone call controller (proxy server, 42, SIP server) operating according to proprietary IP call control protocols and coupled to the global IP network;

(b) a gateway coupled to the global IP network at a location remote from the call controller (column 3, lines 20-25);

(c) one or more non-IP digital PBX telephone handsets coupled to the gateway via wires for carrying non-IP digital PBX telephone call control signaling between the handset and the gateway (column 3, lines 15-25);

(d) the gateway having one or more protocol translating circuits that (column 4, lines 36-50):

(i) translate non-IP digital call control signals received from a handset into IP call control signals according to proprietary IP call control protocols of the call controller (column 5, lines 1-15) and

(ii) translate proprietary IP call control signals from the call controller into non-IP digital call control signals for a handset coupled to the gateway (column 5, lines 1-15).

with regard to claims 2 and 35, Cannon teaches:

wherein the protocol translator circuit is programmable such that it can be programmed to operate properly with each of a plurality of protocols for non-IP digital PBX telephone call control signals (column 4, lines 35-50).

with regard to claims 3 and 36, Cannon teaches:

wherein the protocol translator circuit is programmable such that it can be programmed to operate properly with each of a plurality of protocols for IP telephone call controllers (column 4, lines 35-50).

with regard to claims 4-5, and 37, Cannon teaches:

wherein the protocol translator circuit is programmed by IP download (Options) via the IP port (column 4, lines 1-10).

with regard to claims 6-7, and 38, Cannon teaches:

wherein the download is initiated in response to establishment of an IP session between the gateway and an IP service (column 4, lines 1-18).

with regard to claim 8, Cannon teaches (see figure 2):

wherein, upon receipt at a handset port of one or more predetermined non-IP digital PBX call control signals, instead of or in addition to translating the signal into an IP telephone call control signal, the protocol translator circuit returns a non-IP digital PBX call control signal to the handset port (column 5, lines 1-15).

with regard to claim 9, Cannon teaches (see figure 2):

wherein the one or more non-IP digital PBX handset ports includes a first handset port and a second handset port wherein, upon receipt at the first handset port

of one or more predetermined non-IP digital PBX call control signals, instead of or in addition to translating the signal into an IP telephone call control signal, the protocol translator circuit sends a non-IP digital PBX call control signal to the second handset port (column 5, lines 1-15).

with regard to claim 10, Cannon teaches (see figure 2):

The gateway of claim 9 wherein the call control signals are for establishing a voice conference that includes the first and the second handset ports (column 3, lines 15-35: connecting the telephone, coupled to switch 59, to the telephone, coupled to switch.).

with regard to claims 11 and 41, Cannon teaches:

further comprising an address registration circuit that assigns (IAM message) an address for IP communications to each handset port to which a non-IP digital PBX telephone is coupled (column 3, lines 35-50) and registers (REGISTER message) each address for IP communications with the IP telephone call controller (SIP Server: column 4, lines 1-15).

with regard to claim 12, Cannon teaches:

further comprising a registration circuit that registers (REGISTER message) the gateway with the IP telephone call controller (SIP Server) for subsequent system management (column 4, lines 1-15).

with regard to claims 13, 16, 18, and 42, Cannon teaches (see figure 1):

further comprising:

routing non-voice IP data packets between the IP port and one or more IP sub-ports (personal computers, 39: column 3, lines 20-25);

while providing quality-of-service preference to voice IP data packets translated to and from handset ports coupled to non-IP digital PBX telephone handsets (column 3, lines 256-33).

with regard to claims 39, Cannon teaches (figure 6):

further comprising:

receiving at the handset port a third non-IP digital PBX call control signal (column 5, lines 15-42); and

returning a fourth non-IP digital PBX call control signal to the handset port without delivering a corresponding IP telephone call control signal to the IP port (column 5, lines 15-42).

with regard to claim 40, Cannon teaches:

The method for translating call control signals between an IP network and non-IP digital PBX handsets of claim 34 further comprising:

receiving at a first handset port a fifth non-IP digital PBX call control signal (column 5, lines 1-16); and

sending a sixth non-IP digital PBX call control signal to a second handset port (column 5, lines 1-16).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2619

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14, 19, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon in view of Bailis (WO 00/11818 see IDS 6/27/03).

with regard to claims 14 and 43:

Cannon discloses all of the subject matter as described above except for having an external form of a plug-in card for an IP telephone call controller where the IP port has an external form for coupling to contacts in said IP telephone call controller.

Bailis teaches a switch that Internet telephone gateway, 54, with Network server, 62, as a plug-in card on the switch's backplane in order to lower the cost of the parts and management of the system (see page 5 of the detail description).

Therefore it would have been obvious to one having ordinary skill in the art at the time invention was made to have Network server plug card on the switch (gateway) as taught by Bailis in the system of Cannon in order to lower the cost of the parts and management of the system.

with regard to claims 19, Cannon teaches:

A system wherein non-IP digital PBX telephone handsets are coupled to a gateway in the form of a plug-in card in a proprietary IP telephone call controller in a private telephone network, comprising:

(a) a proprietary IP telephone call controller (proxy server, 42, SIP server) operating according to proprietary IP call control protocols and coupled to the global IP network;

(c) one or more non-IP digital PBX telephone handsets coupled to the gateway card via wires for carrying non-IP digital PBX telephone call control signaling between the handset and the gateway card (column 3, lines 15-25);

(d) the gateway card having one or more protocol translating circuits that (column 4, lines 36-50):

(i) translate non-IP digital call control signals received from a handset into IP call control signals according to proprietary call control protocols of the call controller (column 5, lines 1-15) and

(ii) translate proprietary IP call control signals from the call controller into non-IP digital call control signals for a handset coupled to the gateway (column 5, lines 1-15).

Cannon discloses all of the subject matter as described above except for a gateway card plugged into the call controller.

Bailis teaches a switch that Internet telephone gateway, 54, with Network server, 62, as a plug-in card on the switch's backplane in order to lower the cost of the parts and management of the system (see page 5 of the detail description).

Therefore it would have been obvious to one having ordinary skill in the art at the time invention was made to have Network server plug card on the switch (gateway) as taught by Bailis in the system of Cannon in order to lower the cost of the parts and management of the system.

Response to Arguments

5. Applicant's arguments filed 12/26/07 have been fully considered but they are not persuasive.

Claim 1:

6. The examiner disagrees with the applicant that Cannon does not disclose a handset gateway that includes both handsets and IP ports and a protocol translator circuit. The examiner is to give claims their broadest reasonable interpretation in light of supporting disclosure (In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)). Thus the gateway, 35, in Cannon has both a handset port and IP port, since the gateway communicates with telephone 31, and IP phone, 41. The claim does not state the gateway has to be directly connected to the remote handset, so the gateway can use the PBX connect to the telephone 31. Since the PBX has handset ports (see applicant remarks, page 11, lines 3-7), then the gateway has same ports to the PBX for proper communication to the telephone (remote handset). Since the examiner views the gateway has handset ports and IP ports, then the gateway's signal gateway, 47, is the protocol translator circuit (see figure 2). The signaling gateway translates call controls signals (SIP to ISUP or ISUP to SIP) between ports of the gateway (column 4, lines 36-45). Therefore, Cannon does teach or fairly suggest all the limitations of the claim 1, so claim 1 is not allowable over Cannon.

Claims 15, 19, and 34 are similar to claim 1, so rejection is maintained in view of Cannon disclosure (see claim 1 arguments).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS R. SMITH whose telephone number is (571)270-1096. The examiner can normally be reached on Mon-Thurs: 7:30 am - 5:00 p.m. and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRS 4/14/08

/CHAU T. NGUYEN/
Supervisory Patent Examiner, Art Unit 2619